UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/207,143	12/08/1998	DON HIDEYASU MATSUBAYASHI	36J.P170	6391

5514	7590	03/04/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 June 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>3-5,8-22 and 25-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>3-5,8-10 and 12-22</u> is/are allowed.

6)☒ Claim(s) <u>11,25,26 and 28-30</u> is/are rejected.

7)☒ Claim(s) <u>27</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>12 February 1999</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The following rejection is based on an updated search on, and the newly

cited references found in the updated search.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 11, 26, 28-30 are rejected under 35 U.S.C. 103(x) as being

unpatentable over Joliat et al (US 6,083,007) in view of Laney et al (US

6,366,966).

Regarding claim 11: Joliat teaches method for outputting a quick-start

guide (setting for all possible options, column 6, lines 10-55), said method

comprising the steps of sending a signal (the signal of the installation program,

column 7, lines 60-67) to a computer system (e.g., a PC, column 8, lines 1-15)

that ordinarily would be sent when a memory medium (CDROM, column 7, lines

60-65) has been inserted into a memory medium drive (inherently, a CDROM

drive must be provided to read a CD ROM); wherein when the computer system

executes the executable program (installation program, column 7, lines 67), the

executable program causes the computer system to output an image of the

quick-start guide (column 8, lines 1-15) wherein the quick start guide identifies

installation and configuration instructions.

Joliat does not teach intercepting a request from the computer system for

a filename for the executable program; sending the filename for the executable

program to the computer system in response to the request for the filename;

intercepting a request from the computer system for the executable program; and

sending the executable program to the computer system in response to the

request for the executable program.

Laney, in the same area of loading program from a CDROM (126, fig. 1) to

a computer system, column 2, lines 10-25, column 3, lines 1-45), teaches in

Microsoft Windows environment, an executable program is automatically run

from the CD ROM by: sending the filename for the executable program to the

computer system in response to the request for the filename (shell search

AUTORUN.INF. for a file name, e.g., Demo.Bat, column 3, lines 10-40);

intercepting a request from the computer system for the executable program (the

signal to the CD ROM drive such that the Demo.Bat can be located, inherent

properties when shell from the computer try to locate a file in the CD ROM); and

sending the executable program (inherent properties for the computer to run a

program located in the CD ROM) to the computer system in response to the

request for the executable program.

Therefore, it would have been obvious to a person with ordinary skill in the

art at the time the invention was made to have modified Joliat's program access

method to include: intercepting a request from the computer system for a

filename for the executable program; sending the filename for the executable

program to the computer system in response to the request for the filename;

intercepting a request from the computer system for the executable program; and

sending the executable program to the computer system in response to the

request for the executable program.

It would have been obvious to a person with ordinary skill in the art at the

time the invention was made to have modified Joliat's program access method by

the teaching of Laney because of the following reasons: (a) it would have allowed

users to use Microsoft computer; (b) since Microsoft is one of the biggest

computer software company, using Microsoft computer would have allowed the

user having the greatest selection of the software for his system; and (c) it would

have allowed users to received technical support from the biggest computer

software company.

Regarding claim 26: Joliat teaches detecting information about a device,

(as discussion in claim 11, the quick start guide is outputted based on the

detection of signal for a filename for an executable program in the CD ROM

drive) wherein the image of the quick-start guide is based on the detected

information.

Regarding claim 28: Joliat wherein the computer system has a display

(column 6, line 36) connected thereto, and wherein the image of the quick-start

guide is output through the display.

Regarding claim 29: Joliat teaches wherein the computer system has a

printer connected thereto, and wherein the image of the quick-start guide is

output through the printer onto a recording medium. (column 6, lines 45-50, fig. 4)

Regarding claim 30: Joliat teaches wherein the memory medium is a CD-ROM and the memory medium drive is a CD-ROM drive. (column 7, lines 66-67)

4.   Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joliat et al (US 6,083,007) in view of Laney et al (US 6,366,966) and Crosswy et al. (US 5,325,532)

Regarding claim 25: Claim 25 is claiming a processor and a program memory storing the program step discussed in claim 11. (please see the discussion of claim 11)

Joliat, teaches it is well known in the art to have a program memory storing program steps for a processor/controller (collumn 4, lines 58-60).

Joliat does not teach a processor and a program memory storing the program step for the CD ROM drive.

Crosswy, in the same area of CD ROM drive, teaches a CD Rom drive is having a controller/processor (column 5, lines 40-45).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Joliat/Laney to include: a processor and a program memory storing the program step for the CD ROM drive.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Joliat/Laney by the teaching of

Crosswy because of the following reasons: (a) it would have allowed the CD

ROM drive to be programmed to perform different functions; and (b) it would

have allowed the CD ROM drive to be produced in a large quantities to reduce

cost because new functions/different functions can be added to the CD ROM

drive without changing the hardware of the CD ROM drive.

Allowable Subject Matter

5.   Claims 3-5, 8-10, 12-22 allowed.

6.   Claim 27 is objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Thomas et al (US 6,529,992) teaches the autorun.inf and the autorun.exe

file in a a CD ROM used by Microsoft Windows.

8.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to King Y. Poon whose telephone number is

(703) 3050892.

2/29/04